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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,987	01/08/2001	Rodney Michell Innes	JAMES 46.001	8953

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EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

18

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/673,987

Applicant(s)
Innes

Examiner
S. Mark Clardy

Art Unit
1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 10, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4, 6-9, 11, 12, 14, 16, 17, 19-25, 28-30, 32, 33, 35, 38-40 is/are pending in the application. 42, 43, 47-51
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed. 43, 47-51
- 6) ☒ Claim(s) 1, 2, 4, 6-9, 11, 12, 14, 16, 17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, 47-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

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Claims 1, 2, 4, 6-9, 11, 12, 14, 16, 17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, 47-49, and new claims 50 and 51 are pending in this application in which a Request for Continued Examination has been filed; the application was originally filed under 35 USC 371 as a national stage application of PCT/NZ99/00047, filed April 21, 1999. This application possesses unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)).

Applicants' claims are drawn to agrochemical compositions, methods of making them, and methods of use, comprising:

- a) monoterpen¹ alcohol: a pine oil with at least 60% alcohol content
- b) a fatty acid soap: an alkali metal salt of a tall oil and/or a fatty acid,
- c) optional monocyclic monoterpene aldehydes, ketones, or other materials²,
- d) optional adjuvants and active agents³.

wherein there is sufficient fatty acid soap or foam enhancing agent to form a surface monolayer of bubbles when used.

Note that the end use recited at the end of claim 51 is irrelevant in a composition claim.

Claims 17 and 21 have been corrected.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

¹Claim 8: pinenes, terpineols, borneols, isoborneols, eucalyptus oil, citronellol, liminol, citrus oils

²Claim 9: anethols, fenchols, limonenes, camphenes, thujols, dipentes, eugenols, phellandrenes, cavaracols

³Claim 17: surfactants, foaming agents, emulsifiers, pesticides fungicidal agents, and fertilizer

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are again rejected under 35 U.S.C. 102(a), (b), and (e) as being anticipated by Comparative Example 1b of Barranx et al (US 5,763,468).

Barranx et al, again, teaches disinfectant compositions comprising at least one terpene alcohol and at least one bactericidal acidic surfactant. Comparative Example 1b comprises 20% pine oil and 20% tall oil sodium fatty acid soap. The pine oils used in the patent have a terpenic alcohol content of 88-93% (col 5, lines 26-31), which would appear to be within applicant's range of above 60% or 80%. The composition of the comparative example 1b would appear to inherently possess the characteristics described in functional language at the end of claim 1, i.e., the ability to foam. This is not a mere possibility as asserted in the response. Barranx et al teaches the same components in the same concentration ranges; it thus follows that whatever properties have been noted in applicants' compositions are necessarily present in those disclosed in Barranx et al, whether disclosed therein or not. (It is noted that applicant's preferred ratio of tall oil to pine oil would not allow for equal amounts of these components; see page 19, lines 10-11).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19, 21-25, 28-29, 47-51 are again rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Barranx et al and Richter (US 5,728,672).

The disinfectant compositions of Barranx et al has been discussed above.

Richter teaches pine oil (columns 2-3) cleaning compositions (Abstract) which may also contain anionic surface active agents including fatty acid (C₈₋₂₀) salts (col 9, lines 24-28).

While these patents are from non-analogous art, there is no requirement that the prior art must suggest that the claimed product will have the same or similar utility as that discovered by applicant in order to support a legal conclusion of obviousness, so long as the prior art suggests a reason or provides motivation to make the claimed invention, even where the reason or motivation is based on a something different from that discovered by applicant.

One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of combining terpene or pine oil components with soap materials in disinfectants.

Thus it would have been *prima facie* obvious to one of ordinary skill in the disinfecting composition art at the time the invention was made to have combined applicants' monoterpene alcohol (pine oil) with a fatty acid soap because the prior art teaches that these components were known to be useful in combination as disinfectant compositions. The addition of other optional components (surfactants, emulsifiers, etc.) would have been obvious to the ordinary artisan in the

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disinfectant art. None of applicants' pesticidal methods have been rejected over these references.

As noted above, it would appear that such compositions would possess the ability to foam.

Applicants assert that no additional foaming agents are used to increase the stability of the foam or bubbles; however, note that the comprising language of claim 1 allows for such materials, and claim 17 explicitly recites the optional addition of other foaming agents.

Claims 1, 2, 4, 6-9, 11, 12, 14-17, 19-25, 28-30, 32, 33, 35, 38-40, 42, 43, and 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Pullen et al (US 5,753,593) and Evans et al (US 5,948,731).

Pullen et al teach the utility of terpene oils such as pine oil and various citrus oils (col 2, lines 4-13), in combination with surfactants, preferably the salts of fatty acids (col 3, lines 14-20), as aquatic herbicidal agents. The alcohol content of the pine oil is at least 60% by weight; in column 2, Pullen states:

High terpene containing natural oil as used herein means those natural oils having a terpene content of at least fifty (50%) percent. It is preferable that the high terpene natural oil contains at least ninety (90%) percent."

Thus, the pine oil component of Pullen falls within applicant's range of at least 60%.

Evans et al teach that fatty acid salts were known herbicidal agents.

One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of fatty acid salts in herbicidal compositions.

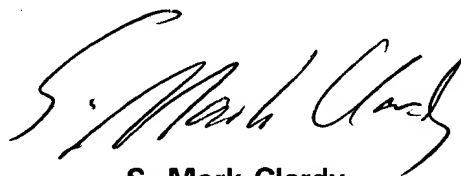
Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' monoterpene alcohol (pine oil) with a fatty acid soap because the prior art teaches that these components were known to be useful in herbicidal

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compositions. The addition of other optional components (surfactants, emulsifiers, etc.) would have been obvious to the ordinary artisan in the herbicidal art. Again, it would appear that compositions comprising the components disclosed herein would necessarily produce foam.

No unobvious or unexpected results are noted; no claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

A handwritten signature in black ink, appearing to read "S. Mark Clardy", is positioned above the printed name and title.

S. Mark Clardy
Primary Examiner
AU 1616

December 13, 2002